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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,669	01/13/2006	Albercht Hofmann	3474	1553

7590
Striker Striker & Stenby
103 East Neck Road
Huntington, NY 11743

EXAMINER

MORGAN, EILEEN P

ART UNIT	PAPER NUMBER
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3723

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/564,669

Applicant(s)

HOFMANN ET AL.

Examiner

Eileen P. Morgan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1-13-06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

Specification

The disclosure is objected to because of the following informalities: the entire specification refers to 'insertion tool 12'. What is an insertion tool? What is the tool inserted into? The only reference to element 12 is in figure 1. No other figures show element 12 which makes the invention unclear. How does the 'insertion tool 12' relate to all the other elements? Reference is made to 'abrasive body 18', but this element is not shown in any figures. How is hub a 'cutting disc' (page 5, line 14)? How are elements 12,18,16 related? Is the abrasive disc and cutting tool the same element? Are these also the 'insertion tool'?

Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims recite 'an insertion tool'. What is an insertion tool? What is the tool inserted into? It is unclear from the specification what other elements further define the insertion tool since element 12 is only showed in figure 1. Claim 1, is the insertion tool inserted into the machine tool? How is the insertion tool different from the machine

tool? Line 1, 'that has a hub' refers to what? The machine tool or insertion tool? 'via which the hub' is unclear. It is totally unclear how the claims further limit 'an insertion tool'. As best understood from the specification, the 'insertion tool' is actually just a grinding disk not inserted into anything. The preamble of the claims recite an 'insertion tool' but do not further limit the tool. Likewise, the drawings do not further limit element 12 since that numeral is not used in the views detailing all the other elements that are not being claimed. Claims 2 and 4, 'in particular, at least 3 mm' and 'in particular radial' are unclear. What exactly is the limitation? Claim 3, how is the 'stop' rotated? The stop is a section of the opening and not able to rotate in and of itself. Claims 7 and 8, what is the 'tangential direction' in reference to? How can the slots be oriented in this direction? Are they tangential relative to each other? This is unclear.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-4, 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Gellert-2747343.

Gellert discloses the claimed invention including a machine tool having clamping means for holding a disk unto a shaft, wherein the disk has a hub (42) having openings (48) including a retaining portion(50) and a releasing portion (52) having a stop (end of

slot 52) which is adjacent a convex section (circular arc), and having retaining means (34), and a central opening (46) for centering hub.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Gellert in view of Timmons-5,207,028.

Gellert does not disclose the center opening (46) having a radial recess. However, Timmons teaches connecting a hub/disk (18) to a central shaft wherein the hub has an opening (28) with a radial recess (hexagonal cuts). Therefore, it would have been obvious to one of ordinary skill in the art at time invention was made to provide the opening of Gellert with radial recesses, as taught by Timmons in order to improve clamping of hub to shaft by providing additional securing means.

Allowable Subject Matter

Claims 2,5-7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen P. Morgan whose telephone number is


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571.272.4488. The examiner can normally be reached on Monday-Thursday, 7am-3:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571.272.4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

EM
January 7, 2007


Eileen Morgan
Primary Examiner